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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/330,852	06/11/1999	DAVID L. REESE	114596-07-4014	9904
38492	7590	09/30/2005	EXAMINER	
WILLKIE FARR & GALLAGHER LLP INTELLECTUAL PROPERTY LEGAL ASSISTANTS 787 SEVENTH AVE NEW YORK, NY 10019-6099			CHAVIS, JOHN Q	
			ART UNIT	PAPER NUMBER
			2193	

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/330,852

Applicant(s)

REESE ET AL.

Examiner

John Chavis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-81 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-81 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/15/05.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Arguments***

***Double Patenting***

1. The code provided in the previous action can be found in that action and will not be cited again here. Furthermore, the applicant should refer to the action dated January 10, 2005 for its contents; since, they will not be repeated here.
2. The provisional double patenting rejection of claims 1-51 remains; since, application 09/425,401 still exists, as indicated in the previous action, and no terminal disclaimer has been filed.
3. Claims 52-81 of this application conflict with claims 1-30 of Application No. 09/425,401. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

***Claim Rejections - 35 USC § 102***

4. Claims 2-15, 17-20, 22, 24-31, 34-40, 44 and 46-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Heisch, as cited in the previous action.

Applicant's arguments filed July 15, 2005 have been fully considered but they are not persuasive. The applicant argues that Heisch does not "record the address of the last byte of at least one multi-byte instruction". However, note in the abstract that Heisch reorders instructions using an actual profile (or instruction **address** trace). Therefore, the feature of recording the address of the last byte is inherently included to provide an indication of where each byte occurs in execution order, see figs. 3, 4 and 8. Specifically, in fig. 3, the first and last bytes are recorded. This is considered to provide for recording the last byte. Therefore, claims 2-15, 17-20, 22, and 24-31 are rejected as indicated in the previous action.

The applicant further indicates that the feature of having "the profiled binary code with sufficient processor mode information to resolve mode-dependency in the binary coding". However, the feature is considered merely a desired result; since, there is no clear indication of a specific method step indicated. The feature merely that the system has sufficient mode information to resolve dependency. Nothing in the claim indicates that the feature actually occurs, just that the system is capable of performing the desired feature. Heisch's system is also considered **capable** of performing the desired feature, see col. 2 lines 38-59, which provides for mode information based on the selected workload (instructions) and the existing hardware (processor mode). Furthermore, the only reference Heisch makes to compiled code is in col. 2 lines 14-25 and nothing there refers to specifically "compiling the program for profiled execution". Therefore, it is considered that the feature is not a requirement in Heisch's system and the features of claims and 34-40 are considered taught by Heisch, as indicated in the previous action.

Claims 4, 6, 37 and are rejected as cited in the previous action in which reasoning has been provided.

The features of claim 3, 5, 7-15, 17-20, 22, 24-31, 34-40, 44 and 46-49 has also been discussed sufficiently in the previous action.

5. Claims 1 would be allowable over the art of record once a terminal disclaimer is filed.

6. Claims 16, 21, 23, 32-33, 41-43, 45 and 50-51 are objected to as dependent on a rejected base claim and would be allowable over the art of record if rewritten to include all limitations of its respective parent, and further in view of a terminal disclaimer being timely provided.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Chavis whose telephone number is (571) 272-3720. The examiner can normally be reached on M-Th, 8:30am-5:00pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jc



John Chavis  
Primary Examiner AU-2193